

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) **OO-0006					
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____	Application Number 09/866,765	Filed May 30, 2001					
	First Named Inventor Gregory A. Hodge						
	Art Unit 2421	Examiner Chenea Smith					
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top; padding-bottom: 10px;"><input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>60,436</u></td><td style="width: 50%; vertical-align: top; padding-bottom: 10px; text-align: right;">/Jon M. Isaacson/ _____ Signature Jon M. Isaacson _____ Typed or printed name 215-568-3100 _____ Telephone number February 4, 2009 _____ Date</td></tr><tr><td style="vertical-align: top;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td></td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>60,436</u>	/Jon M. Isaacson/ _____ Signature Jon M. Isaacson _____ Typed or printed name 215-568-3100 _____ Telephone number February 4, 2009 _____ Date	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	
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<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____							
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.							

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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DOCKET NO.: **OO-0006
Application No.: 09/866,765
Office Action Dated: September 4, 2008

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Gregory A. Hodge and Bernie L. Gibson Confirmation No.: **5021**
Application No.: **09/866,765** Group Art Unit: **2421**
Filing Date: **May 30, 2001** Examiner: **Chenea Smith**
For: **METHODS AND APPARATUS FOR INTERACTIVE TELEVISION**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated on the attached sheets. No more than five pages are provided.

REMARKS

Summary of Official Actions

Claims 44-115 are pending in the present application and all claims stand rejected. Claims 44, 53, 62, 77, 92, and 101 are the independent claims. Pre-appeal review of the outstanding rejections is requested because, in our view, the cited art fails to teach or suggest all of the recitations of at least the independent claims.

In an Official Action dated September 4, 2008 (“Final Rejection”), the independent claims were rejected under 35 USC § 102(b) as being anticipated by Broadwin, US Patent 5,903,816 (“Broadwin”). The remainder of the dependent claims, namely claims 45-52, 54-61, 63-76, 78-91, 93-100 and 101-115, were rejected either under 35 USC § 102(b) as being anticipated by Broadwin or were rejected under 35 USC § 103(a) as unpatentable over Broadwin in view of at least one other reference. The rejections of the dependent claims all rely on Broadwin to anticipate the independent claims.

In an Advisory Action dated December 23, 2008 (“Advisory Action”), the examiner maintained all of the rejections. The examiner also entered applicants’ proposed amendments for purposes of appeal.

Brief Overview of Applicants’ Claimed Subject Matter

The claimed subject matter relates generally to interactive television and, more particularly, to interactive television for promoting and selling products. One aspect of the independent claims is that an electronic file, which includes an interactive icon and a first content, is received along with a video signal including a second content. Further, instructions are generated which configure a set-top box to (1) overlay the interactive icon in the electronic file on at least a portion of the second content in the video signal, and (2) display the first content if the interactive icon is selected. The video signal, the instructions for the set-top box, and the electronic file are combined into a first channel, and that first channel is combined with a second channel into a broadcast signal. Finally, the broadcast signal is transmitted to a set-top box.

Broadwin's Failure to Anticipate Applicants' Claimed Subject Matter

Applicants submit that their independent claims are patentably defined over Broadwin for at least the reason that Broadwin fails to teach receiving an interactive icon and first content, and then generating instructions for a set-top box based on the received first content.

As amended for purposes of appeal, claim 44 recites, in part:

receiving an electronic file, wherein the electronic file includes an interactive icon and first content;

receiving a video signal including second content;

generating instructions for a set-top box, wherein the instructions for the set-top box configure the set-top box to overlay the interactive icon in the electronic file on at least a portion of the second content in the video signal and the instructions for the set-top box configure the set-top box to display the first content if the interactive icon is selected.

Thus, claim 44 recites receiving (1) an interactive icon, (2) a first content, and (3) a second content from a video signal. Further, claim 44 recites generating instructions to configure a set-top box (1) to overlay the interactive icon on the second content, and (2) to display the first content if the interactive icon is selected.

In the Final Office action, the examiner rejected claim 44 under 35 USC § 102(b) as being anticipated by Broadwin as follows:

receiving an electronic file (interactive application content, see col 5, lines 2-10), wherein the electronic file includes an interactive icon (see selections options, see col 7, lines 34-41) and first content (see col 5, lines 2-10),

receiving a video signal including second content (audiovisual content, see col 4, lines 57-63),

generating instructions for a set-top box (see col 5, lines 1-10), wherein the instructions for the set-top box are configured to overlay the interactive icon (see selections options, see col 7, lines 34-41) in the electronic file (interactive application content, see col 5, lines 2-10) on at least a portion of the second content (audiovisual content, see col 4, lines 57-63) in the video signal (see col 7, lines 28-41) and the instructions for the set-top box are configured to display the first content if the interactive icon is selected (see col 7, lines 48-53).

(Final Rejection, page 2.) Thus, the examiner cited to col. 5, lines 1-10 of Broadwin as teaching both receiving an electronic file (Broadwin's electronic file) and generating

instructions for a set-top box based on the received first content, second content and interactive icon. The cited portion of Broadwin states:

The broadcast center also includes an application server *for creating and/or generating interactive application content*. The interactive application content comprises application code and data which is designed to be executed by a processor within a set top box or television to support an interactive television feature. The application server is preferably configured for generating or providing “OpenTV” interactive applications. The application server may also provide “Java” applets or other interactive program content, as desired.

(Broadwin, col. 5, ll. 1-10; emphasis added, figure element numbers removed.) Thus, the cited portion of Broadwin teaches “creating and/or generating” interactive content, including code for executing the interactive content on a set-top box. Applicants respectfully submit that Broadwin’s generating an interactive icon does not teach receiving an electronic file with a first content, as recited by claim 44. Further, claim 44 recites generating instructions for the set-top box to overlay the received interactive icon on the received second content and generating instructions for the set-top box to display the received first content if the received interactive icon is selected. While Broadwin may teach generating interactive content including the code necessary for a set-top to execute the content, Broadwin fails to teach generating instructions for integrating a received first content with a received interactive icon and a received second content. The recited claim 44 has at least the advantage that the first content and the second content are received from potentially different entities and the instructions for combining the contents are generated by the distributor.

In the Advisory Action, the examiner further states that he “believes that if instructions are configured to perform a task, and the instructions are stored on a device to be executed by a processor, then the device is configured to perform the task.” (Advisory Action, page 2.) Without admitting that the examiner’s belief is correct, applicants respectfully submit that, whether or not Broadwin’s instructions configure the device, Broadwin fails to disclose receiving a first content and generating instructions based on that first content, as discussed above.

For at least the reasons discussed above, applicants respectfully submit that claim 44 is patentably defined over the cited art. Accordingly, applicants respectfully request withdrawal of the rejection of claim 44 under 35 USC § 102(b).

The remaining independent claims, claims 53, 62, 77, 92 and 101, stand rejected under 35 USC § 102(b) for the same reasons as the rejection of claim 44 discussed above. For at least the reasons discussed above, applicants respectfully submit that claims 53, 62, 77, 92 and 101 are patentably defined over the cited art. Accordingly, applicants respectfully request withdrawal of the rejection of claims 53, 62, 77, 92 and 101 under 35 USC § 102(b).

As discussed above, the rejections of dependent claims 45-52, 54-61, 63-76, 78-91, 93-100, and 101-115 all rely on Broadwin to anticipate the independent claims. For at least the reasons discussed above regarding the independent claims, applicants respectfully submit that claims 45-52, 54-61, 63-76, 78-91, 93-100, and 101-115 are patentably defined over the cited art. Accordingly, applicants respectfully request withdrawal of the rejection of claims 45-52, 54-61, 63-76, 78-91, 93-100, and 101-115 under 35 USC §§ 102(b) and 103(a).

Conclusion

For at least the foregoing reasons, applicants submit that the independent claims are patentably defined over the cited art. Applicants respectfully request either allowance of the existing claims, or, alternatively, a reopening of prosecution on the merits and an appropriate Office communication in due course. If appropriate, applicants respectfully request a proposed amendment proposing changes that, if accepted, may result in an indication of allowability for the contested claims.

Should the examiner have any questions or concerns that might be efficiently resolved by way of a telephonic interview, the examiner is invited to call applicants' undersigned attorney, Jon M. Isaacson, at **206-332-1102**.

Date: February 4, 2009

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